

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed November 7, 2005. Claims 1, 10, 14, 23, 25, and 28 are amended and new claims 29-33 are added. Claims 1-33 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, the Applicant requests that the Examiner carefully review any references discussed below to ensure that the Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. Claim Objections

The Examiner objects to claim 10 because of the use of the term "hot swappable power connectors". In response, the Applicant amends claims 10 to replace the term "hot swappable power connectors" with "hot-swap connectors" which is consistent with page 12 of the Applicant's specification.

II. CLAIM REJECTIONS

A. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1, 6-11, 14-18, 20-23, and 27 under 35 U.S.C. § 103 as being unpatentable over *McCarthy et al.* (U.S. Patent No. 5,638,259) in view of *Hutson et al.* (U.S. Patent No. 6,091,609). The Applicant traverses the Examiner's rejection for obviousness on the grounds that the Examiner has failed to show that the references – either individually or in

combination – fail to teach or suggest each and every element of the rejected claims as required for a *prima facie* case of obviousness.

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

(Emphasis added).

According to the Office Action on page 3, “McCarthy et al. disclose a housing (10) for receiving any type of module including network tap modules (column 5, lines 6-7)....” (Emphasis added). Analogous language is used on page 7 of the Office Action for the rejection of independent claim 23. However, column 5, lines 6-8 of *McCarthy* actually discloses, “[f]urthermore, the function or purpose of the electronic components on any module or card does not have any bearing on the present invention.” In direct contrast to the assertions made in the Office Action, this portion of *McCarthy* does not teach or suggest network tap modules.

It is well established that “every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines.” *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970) (emphasis added); *See also In re Wilson*, 165 USPQ 494 (CCPA 1970) (“all words in a claim must be considered in judging the patentability of that claim against the prior art”) (emphasis added). The Examiner cannot selectively ignore certain elements of the claims by merely purporting that such elements exist in broad self-serving statements of *McCarthy*. Rather, evidence of record must teach or suggest the element “hot-pluggable network tap modules” as recited in independent claims 1 and 23.

In fact neither *McCarthy* nor *Hutson* relate to network tap modules. “[The Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 154, USPQ 173, 178 (CCPA 1967). The PTO cannot simply make conclusions based on its own understanding or experience – or on its allegation of what would be basic knowledge or common sense. Rather, the PTO must point to some concrete evidence in the record in support of the findings. *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added; footnote omitted).

It may be that the Examiner is relying on personal knowledge as evidence not set forth in the Office Action to fill the evidentiary gaps in *McCarthy* and *Hutson*. If personal knowledge is being relied upon in this Office Action (or future office actions), the Applicant hereby respectfully requests an Examiner affidavit pursuant to 37 C.F.R. 1.104(d)(2) that: (i) specifically identifies any and all references(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 1, 6-11, 14-18, 20-23, and 27 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 1, 6-11, 14-18, 20-23, and 27.

A *prima facie* case of obviousness has not been set forth because the Examiner has not shown concrete evidence that every element of independent claims 1 and 23 is taught or suggested. As such, the Applicant respectfully requests that the rejection of independent claims 1 and 23 be withdrawn. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Therefore, the Applicant respectfully requests that the rejection of dependent claims 6-11, 14-18, 20-22, and 27 be withdrawn at least for the same reasons as claims 1 and 23 from which they depend.

Moreover, with regard to claims 14-16, the Applicant further notes that the Office Action also appears to mischaracterize the teachings of *McCarthy* with regard to the elements a “barrel plug retainer assembly,” a “barrel plug retainer” and “a plurality of barrel plugs.” According to the Office Action on page 5, “*McCarthy* further discloses a barrel plug retainer assembly (110) that includes a barrel plug retainer (140) and a plurality of barrel plugs (142) used to provide power to the hot-pluggable network tap modules (column 3, lines 40-50; column 8, lines 30-45, 60-70.” However, column 8, lines 54-60 of *McCarthy* recites the following:

FIG. 9 shows the back side of switch 110. The back plate 132 has a receiving aperture in which the toggle bat 142 from switch circuit 140 is mounted on the card 18. In the off position, switch 110 holds the toggle bat 142 in a downward position thereby keeping switch circuit 140 off. As is well known, with switch 140 in the off position, the common power is removed from the module or card 18.

These portions of *McCarthy* indicate that reference number 110 is a switch, reference number 140 is a switch circuit, and reference number 142 is a toggle bat in *McCarthy* as opposed to a barrel plug retainer assembly, a barrel plug retainer, and a plurality of barrel plugs respectively as asserted by the Examiner. It is unclear to the Applicant how the Examiner has interpreted the scope of the terms used in claims 14-19 to include the switch, switch circuitry, and toggle bat disclosed by *McCarthy*. The MPEP requires the Examiner to “clearly communicate the findings, conclusions and reasons which support [the rejections]” (MPEP 2106 VII), and the Applicant requests this level of clarity and specificity in future office actions as to how a “switch,” “switch circuitry,” and “toggle bat” come within the scope of the structural elements “barrel plug retainer assembly,” “barrel plug retainer,” and “plurality of barrel plugs” used in the claims.

The Examiner rejects claims 2-5 and 28 under 35 U.S.C. § 103 as being unpatentable over *McCarthy* in view of *Hutson*, further in view of *Varghese et al.* (U.S. Patent Application Pub. 2001/0037985). The Applicant traverses the Examiner’s rejection for obviousness on the

grounds that the references – either individually or in combination – fail to teach or suggest each and every element of the rejected claims.

Claim 1 is discussed above. Claims 2-5 depend from claim 1. As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. Therefore, the Applicant respectfully requests that the rejection of claims 2-5 be withdrawn at least for the same reasons as claim 1 set forth above.

Regarding claim 28, the Office Action purports on page 10 that *McCarthy* discloses “a housing for receiving any type of module including network tap modules (column 5, lines 6-7)....” (Emphasis added). As discussed above, column 5, lines 6-7 of *McCarthy* sets forth the following, “[f]urthermore, the function or purpose of the electronic components on any module or card does not have any bearing on the present invention.” In direct contrast to the assertions made in the Office Action, this portion of *McCarthy* does not teach or suggest network tap modules. Therefore, a *prima facie* case of obviousness has not been set forth because the Examiner has not provided concrete evidence of record that every element of independent claim 28 is taught or suggested as purported. As such, the Applicant respectfully requests that the rejection of claims 1 and 28 be withdrawn.

The Examiner rejects claim 12 under 35 U.S.C. § 103 as being unpatentable over *McCarthy* in view of *Hutson*, further in view of *Young et al.* (U.S. Patent No. 6,018,456). Claim 1 is discussed above. Claim 12 depends from claim 1. As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. Therefore, the Applicant respectfully requests that the rejection of claim 12 be withdrawn at least for the same reasons as claim 1.

The Examiner rejects claims 13 and 24-26 under 35 U.S.C. § 103 as being unpatentable over *McCarthy* in view of *Hutson*, further in view of *Bresniker et al.* (U.S. Patent Application Pub. 2003/0084359 A1). Claims 1 and 23 are discussed above. Claim 13 depends from claim 1 and claims 24-26 depend from claim 23. As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. Therefore,

the Applicant respectfully requests that the rejection of claims 13 and 24-26 be withdrawn at least for the same reasons as claims 1 and 23 discussed above.

The Examiner rejects claim 19 under 35 U.S.C. § 103 as being unpatentable over *McCarthy* in view of *Hutson*, further in view of *Garnet et al.* (U.S. Patent Application Pub. 2003/0084359 A1). Claim 1 is discussed above. Claim 19 depends from claim 1. As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. Therefore, the Applicant respectfully requests that the rejection of claim 19 be withdrawn at least for the same reasons as claim 1.

CONCLUSION

In view of the foregoing, Applicant believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 16 day of March, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D.A. Jones' with a stylized flourish at the end.

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